

Remarks

This is in response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed March 17, 2009. Claims 1, 3, and 5 are amended. Support for the amendments is found throughout the figures. Claims 1-6 are pending. Reconsideration and allowance are requested for at least the following reasons.

I. Rejection

In the final Office Action mailed September 3, 2008, claims 1-6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Miranda (U.S. Patent No. 6,107,575). Claims 1-6 are, in the alternative, rejected under 35 U.S.C. § 103(a) as being unpatentable over Bernard in view of Miranda. Applicants respectfully traverse the rejections. Reconsideration is requested for at least the following reasons.

II. Statutes, Laws, and Rules

To anticipate, a reference must teach each and every claim limitation. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP 2131. To render obvious, one or more references must teach every claim limitation. 35 U.S.C. 103(a); MPEP 2141. References cannot be combined when one reference teaches away from the suggested combination. See KSR Int'l v. Teleflex Inc., 127 S. Ct. 1727, 1740 (citing United States v. Adams, 383 U.S. 39, 50-51, 86 S. Ct. 708 (1966)); MPEP 2143.01 and 2145(X)(D)(2).

III. Analysis

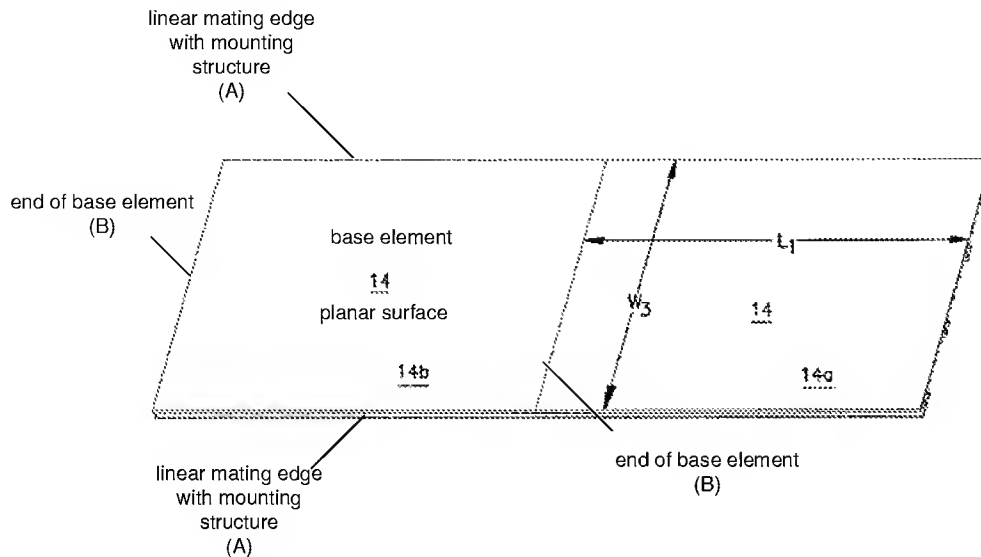
A. Claim Rejections – 35 U.S.C. § 102

The final Action concedes that Miranda fails to disclose the method recited by claims 1-6.

For example, the Action concedes that Miranda fails to disclose or suggest a second plurality of the side elements defining side exits extending transversely relative to the linear mating edges, and generally parallel to the planar top surface, as recited by claim 1.

Miranda also lacks a planar top surface being planar along an entirety of the base element extending between the first end and the second end, and between a first of the linear mating

edges to a second of the linear mating edges, as recited by claim 1. Examples of base elements 14 configured in the manner recited in claim 1 are shown below.



Application, Fig. 2 (annotations added). As shown in Figure 2, each base element 14 includes linear mating edges “A” and ends “B.” Each base element 14 is planar along an entirety of the planar top surface of the base element 14 between the linear mating edges A and the ends B.

In contrast, Miranda discloses that a locking structure of an element 2 of Miranda is elevated with respect to the top surface of the element 2, as shown in Figure 1 of Miranda reprinted below in Section III(B)(ii).

Miranda therefore fails to anticipate claims 1 and 2. Claims 3-6 are allowable over Miranda for similar reasons.

B. Claim Rejections – 35 U.S.C. § 103

The final Action concedes that Bernard fails to disclose or suggest a base element and a plurality of side elements mounted thereto. Instead, the Action states that it would have been obvious to form the cable routing system disclosed by Bernard from separate elements as taught by Miranda. This statement is respectfully traversed for at least the following reasons.

i. The Purported Combination Lacks a Base with Planar Surface

As noted above, Miranda lacks a planar top surface being planar along an entirety of the base element extending between the first end and the second end, and between a first of the linear mating edges to a second of the linear mating edges, as recited by claim 1.

Bernard also lacks such a planar top surface. None of the duct couplers or fittings disclosed by Bernard includes a planar top surface being planar along an entirety of the element. For example, as shown in Figures 10-12 of Bernard, all of the fittings include curved walls. None of the fittings includes a planar top surface along an entirety of the fitting. Bernard therefore fails to disclose a planar top surface being planar along an entirety of the base element extending between the first end and the second end, and between a first of the linear mating edges to a second of the linear mating edges, as recited by claims 1 and 2.

Claims 3-6 are allowable over Miranda for similar reasons.

ii. The Purported Combination Lacks a Base with Continuous Cross-Section

The Advisory Action mailed December 18, 2008 states the following.

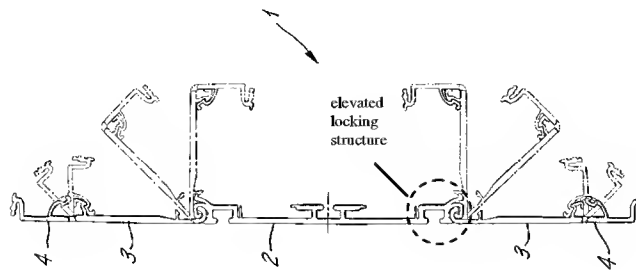
The examiner maintains that one of ordinary skill in the art would know how to incorporate such [a] side exit [of Bernard] between two sections of the duct system of Miranda by way of a duct coupler...

Advisory Action, p. 4, ll. 5-8. This purported combination would apparently require that two longitudinal channels of Miranda are connected by an intermediate side exit fitting of Bernard using a coupler. Such a combination, if it could be made, would not arrive at the claimed inventions.

Claim 1 requires that the linear mating edges of the base element have a continuous cross-section. Therefore, only the sides of the element extending in the longitudinal direction qualify as the linear mating edges, since only the sides that have a continuous cross-section. See the annotated figure printed above.

In contrast, the Advisory Action suggests connecting the ends of two longitudinal sections of the channel disclosed by Miranda with a coupler and side exit fitting disclosed by Bernard. Such a combination would not result in the claimed inventions, since the ends of the channels disclosed by Miranda do not have continuous cross-sections, as required by claim 1.

Further, if the side elements 3 of Miranda could be coupled to the fittings shown in Figures 10 and 12 of Bernard, the locking structure of the element 2 of Miranda would be required, as shown in Figure 3 of Miranda. This locking structure is elevated with respect to the top surface of the element 2, as shown in Figure 1 of Miranda, reprinted below (annotations added).



This elevation of the locking structure of Miranda would not allow side exits to extend transversely relative to the linear mating edges, and generally parallel to the planar top surface, as required by claim 1.

As such, the purported combination of Miranda with Bernard does not teach all of the limitations of claims 1 and 2. Claims 3-6 are allowable over Miranda for similar reasons.

iii. The References Teach Away from the Purported Combination

Bernard teaches away from the purported combination with Miranda because Bernard states the following:

The coupler 100 has an inner wall consisting of two side walls 110 and a bottom wall 120, which are preferably integral and continuous.

Bernard, col. 3, ll. 5-7 (underling added). Bernard therefore requires couplers and troughs with integral walls and teaches away from forming a base element and a plurality of side elements mounted thereto. Bernard cannot be combined with Miranda.

iv. The References Cannot be Combined as Suggested

Miranda discloses a linear channel section with pivotable wall elements. In contrast, the elements of Figures 10 and 12 of Bernard that are identified in the Action are fittings. Such

fittings are typically attached to the ends of linear sections. See, for example, Fig. 1 of U.S. Patent No. 6,739,795, which shows a linear trough 12 coupled to a fitting 18 by a coupler 14.

There is no suggestion provided as to how one would take the fittings disclosed by Bernard and incorporate the linear sections disclosed by Miranda to arrive at the claimed inventions. For example, the Action fails to identify how the fittings disclosed in Figures 10 and 12 of Bernard could be coupled to the longitudinal sides of the element 2 of Miranda. Such a combination, as suggested in the Action, could not be made.

v. There is No Suggestion to Make the Purported Combination

In addition, there is no suggestion as to how or why one skilled in the art would be motivated to modify the fittings disclosed by Bernard based on the channels disclosed by Miranda to arrive at the claimed methods. Claims 1-6 do not simply recite methods that include breaking a cable routing system into various elements, but instead recite specific structures for each of the elements that allow the elements to be assembled according to the steps of the claimed methods. Neither Bernard nor Miranda, alone or in combination, discloses or suggests assembly methods for cable routing systems as recited in claims 1-6. Further, even if the fittings disclosed by Bernard could be broken into separate elements, there are literally thousands of different ways in which the elements could be formed. It is therefore respectfully suggested that it would not have been obvious to try because there are not simply a finite number of identified, predictable solutions.

IV. Conclusion

Favorable reconsideration in the form of a Notice of Allowance is respectfully requested. Please contact the undersigned attorney with any questions regarding this application. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 13-2725.

S/N 10/685,770

The Commissioner is hereby authorized to charge any additional fees as set forth in §§ 38 CFR 1.16 to 1.18 which may be required for entry of these papers or to credit any overpayment to Deposit Account No. 13-2725.

Respectfully submitted,
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